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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,360	03/29/2001	Suruliappa Gowper Jeganathan		1176

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PATENT DEPARTMENT
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EXAMINER

WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 04/02/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-4

Office Action Summary

Applicant(s)

09/806,360

Applicant(s)

JEGANATHAN ET AL.

Examiner

Amanda C Walke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The present claims present the limitation "L is "Q interrupted Q-C4-C12 alkylene-Q when Q is oxygen or -NH-" (pages 51-53 and page 69). It is unclear as to how these groups may be interrupted in this manner.

3. Claims ~~11~~, ~~13~~, and ~~16~~ provide for the use of a compound, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims ~~11~~, ~~13~~, and ~~16~~ are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the

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explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 and 3 recite the broad recitation "m is 0 or a number from the range 1-12", and the claim also recites "preferably 1-6" which is the narrower statement of the range/limitation.

In the present instance, claim 1 recites the broad recitation "v is 1-8", and the claim also recites "preferably 1 or 2" which is the narrower statement of the range/limitation.

In the present instance, claim 5 recites the broad recitation "R7 and R9 are..., and R8, R10, and R11 are...", and the claim also recites "especially wherein at least 2 of the residues R7-R11 are H" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-5 and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Odenwalder et al (5,981,160).

Odenwalder et al disclose a color photographic material comprising in at least one layer a compound of the general formula (I), which has the same basic structure as the present formula (I). In the formula of the reference (the present "n" is 1), the present position R₁ is a radical of the present formula (II), R₆ is hydrogen, and the substituents in the present positions R₂-R₅ and R₇-R₁₁ fall within the present claim limitations. R₉ may be a -O-R₁ (alkyl) group which appears to meet the limitation of the present claims which states that R₉ is a C₁-C₂₅ alkyl group that may be interrupted by oxygen. R₄ may be a alkyl group (see definition of reference R₃ and see compounds in columns 1-7). The compounds are DOP scavengers and are used in an amount of 5 to 1000 mg/M² (column 9, lines 9 and 10). The material contains a pyrazolotriazole magenta coupler (column 11, lines 14 and 15). The compounds of formulas (I) may be present in an emulsion layer and/ or an interlayer (claims 1 and 4-7). Additionally, claim 11 is a use claim. In order to meet the claim limitations, the compound has only to be *capable* of being used in the claimed manner.

7. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Birbaum et al (5,597,854). Column and line citations are for the U.S. Patent.

Birbaum et al disclose a silver halide photographic material containing a stabilizer meeting the structural limitations of the present claims (column 29, lines 39-51 ("14." Teaches compounds of formula V, column 34, lines 31-65). The stabilizers are employed for stabilizing organic materials against the harmful effects of light, oxygen, and/or heat (see abstract). The compound may be added to a layer containing a UV absorber such as a protective layer or a layer

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between the red and green sensitive emulsion layers. The green sensitive emulsion layer contains a magenta coupler which is a pyrazolopyrazole, pyrazolotriazole, or pyrazolotetrazole (column 34, line 1 to column 35, line 57). From the weight of the polymer coating composition in column 59, and the teaching in column 29 that the stabilizer may be added in an amount of 0.1 to 5 % by wt of the polymer (s), the amount of stabilizer added to the layer (s) would fall within the scope of the present claim 8. With respect to the present claim 11, the claim is a use claim, therefore the compound only needs to be *capable* of being used in the claimed manner.

Compounds of structure similar have been added to a silver halide photographic material in an interlayer as a DOP scavenger although this compound is mentioned as being a stabilizer. It is therefore the position of the examiner that the compound is *capable* of being used in the claimed manner and that when added to a photographic material would behave as a DOP scavenger even though it may be added for a different purpose.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 14-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Birbaum et al in view of Hinsken et al (4,325,863).

Birbaum et al has been discussed above, but fails to specifically describe a compound meeting the limitations of the present formula VI. The reference cites Hinsken et al as describing

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suitable benzofuranone compounds. Those exemplified by Hinsken et al teach that the present R2 and R4 groups may contain pentyl groups and teach that they are equivalent to butyl groups (see compound 8).

Given the teaching of Hinsken et al that suitable substituents for positions R2 and R4 include pentyl groups, it would have been obvious to one of ordinary skill in the art to prepare the material of Birbaum et al using the benzofuranone compounds described in "14" of column 29 replacing the butyl group with a pentyl group given that they are taught to be equivalent by the reference, with reasonable expectation of forming a material having increased protection against light, oxygen, and/or heat.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition to all of the references cited by applicant on the PTO-1449, Birbaum et al (GB 2,294,043), Hughes et al (WO/94/12501), Nasvadba (EP 589839), and Hinskin et al (4,338,244) is cited for its teachings of similar compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 703-305-0407. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9792 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


ACW

March 25, 2002

Amanda C Walke
Examiner
Art Unit 1752



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